



UNITED STATES PATENT AND TRADEMARK OFFICE

HD

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,231	04/11/2002	Harry Gozlan	S857.312-1	9979

164 7590 04/17/2007
KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
----------	--------------

3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/980,231

Applicant(s)

GOZLAN, HARRY

Examiner

Frantzy Poinvil

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/27/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1 and 11, the term "IT" is an acronym which is inconsistent with 112 second paragraph. The applicant is suggested to rewrite the acronym "IT" with its full wording. Also as per claims 1, 6, the phrase "in such a way..." or the "such that..." language of claims 2-5, 7, 9, 9 and 11 are considered as intended use language having no patentable weight in the respective claims.

Also, as per claim 1, line 16, "the relevant orders" lack clear antecedent basis. Also, what is an "Internet type" as recited on line 12 ?

As per claim 3, line 6, "the parameters" lack clear antecedent basis. Also what are "internal and/or external parameters" ?

As per claims 3 and 8, what does it mean by "the conclusion of the order(s)" ? Also, regarding claims 3 and 8, the phrase "for example" renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

As per claim 4, the phrase "may occur" renders the claim vague and indefinite because it is unclear whether the function is being performed.

Claims 6 and 7 provide for the use of achieving certain steps or stages or results, but remain unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 6 and 7 are also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

As per claim 8, line 6, "the parameters" lack clear antecedent basis. Also what are "internal and/or external parameters" ?

As per claim 11, the intended use language of "said system being more particularly intended to collect all the interests of the traders pf the plurality of banks" are considered as intended use language having no patentable weight in the claim. Also, "the plurality of banks" lacks clear antecedent basis.

The claims are also replete with alternate language of "and/or" rendering the claims vague and indefinite.

Claims not specifically addressed are rejected based on their dependency.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3692

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al (US Patent No. 6,029,146).

As per claim 1, Hawkins et al disclose a method and apparatus for trading securities electronically. The system and method comprise at least one central server including collection and storage means to collect, in real or pseudo-realtime, orders to buy and sell placed by user, computer processing means to compile and aggregate by price orders subject to terms of validity, the computer processing means comprising management means to manage the terms by only taking into account valid orders, in such a way that an optimized and homogeneous offer is thus obtained.

The server center being connected via an IT communications network particularly to the Internet type, to the computer terminals, in such a way that the users receive the orders and data sent by the server center; the computer processing means of the server center including analysis means to match compatible orders and indicate that a transaction may occur between users placing the relevant orders. Applicant is directed to column. 4, line 64 to column 5, line 18, column 9, lines 52-65, column 12, lines 59-67.

As per claims 6 and 7, Hawkins et al disclose a process for processing, by mutual agreement, between users having computer terminals, orders to buy and sell relating to standard and/or specific financial instruments the process including the following stages:

Art Unit: 3692

orders to buy and sell placed by users are collected in real or pseudo-real time;

the orders are subject to terms of validity are compiled and aggregated by price, by managing said terms in such a way that only valid order are taken into account the orders are allocated to the users, the orders are matched when they are compatible, when two orders have been matched a transaction is made. Applicant is directed to column 4, line 64 to column 5, line 18, column 9, lines 52-65, column 12, lines 59-67.

As per claim 7, Hawkins et al disclose to match the orders users are selected who are able to negotiate between themselves and/or who are only able to negotiate certain instruments and/or who are only able to negotiate deals of a certain amount. See column 11 of Hawkins et al.

As per claim 2, Hawkins et al disclose a to match the compatible orders and indicate that a transaction may occur between users placing the relevant orders, the analysis means comprises selection means to select users who are able to negotiate between themselves and/or who are only able to negotiate certain instruments and/or who are only able to negotiate deals of a certain amount (see column 3, lines 25-38; column 15, lines 63-67 and figure 18).

As per claims 3 and 8, Hawkins et al disclose the computer processing means process the orders and associated financial instruments by managing:

the terms of existence of said orders, particularly in relation to internal and/or external conditions, for example the value of the CAC index, and/or

the parameters of said orders, particularly as a function of internal and/or external parameters, for example the price as a function of the date, and/or

by batching the orders and by placing batched orders, and/or

by seeking synthetic financial instruments to facilitate the conclusion of the orders placed, and/or

by seeking synthetic financial instruments to allow a designated group of users to negotiate a maximum number of orders with at least one other user.

See column 6, lines 25-45 and column 11, lines 1-9.

As per claims 4 and 9, Hawkins et al disclose the analysis means to match compatible orders and indicate that a transaction may occur include transmission means, particularly by fax, by e-mail or by telex, to confirm the transaction to each of the users concerned. See column 11, lines 47-56 and column 10, lines 19-33.

As per claims 5 and 10, Hawkins disclose the collection means comprise an Internet browser and collects data in real time or in pseudo-real time. See column 12, lines 59-67 and column 10, line 64 to column 11, line 9.

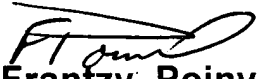
Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frantzy Poinvil
Primary Examiner
Art Unit 3692

FP
April 12, 2007